

REMARKS

Claims 1-5 have been canceled herein. Such cancellation is without prejudice on the merits to further prosecution of these claims in one or more continuing applications.

Claims 6-23 are newly added. The new claims find support throughout the specification and claims as filed. No new matter is added. Favorable reconsideration is respectfully requested.

The following remarks address the issues presented in the Final Office Action in order of their appearance.

Rejection of Claims 6-23 Under §112, First Paragraph (New Matter/Written Description):

This rejection is believed to have been overcome, in part, by appropriate amendment to the claims and is, in part, respectfully traversed.

The Office has objected to the recitation of the float in Claims 6, 13, and 19, as being submerged "within any liquid in a tank." See page 2, paragraph 2 of the Final Office Action. Applicants submit that this rejection has been overcome, at least in part, by amending the claims to remove the term "any." As the phrase now appears in the claims, the first appearance of the word "liquid" has no preceding article, while the subsequent appearances of the word "liquid" are preceded by the definite article "the."

Regarding new matter, Applicant respectfully makes two points: (1) the exact language appearing in the claims does not have to appear in the specification; and (2) the drawings are part of the original application as filed. In short, the test for sufficiency of support in a parent application is whether the disclosure of the application relied upon "reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter." *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985) (quoting *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983)).

Applicants therefore traverse this rejection, in part, because Fig. 6 clearly shows the float 39 in a first position above the liquid 37 in the tank and Fig. 7 clearly shows the float 39 a second position submerged within the liquid in the tank. Both Figs. 6 and 7 clearly show that the float 39 is configured such that second end of the flexible tubing 35 is submerged within liquid in the tank in which the flush valve is disposed.

Because these elements as recited in the claims are clearly depicted within the drawings, Applicants submit that this rejection is untenable. Withdrawal of the rejection is respectfully requested.

Rejection of Claims 6-9 Under §102(b) in View of Aaron, U.S. Patent No. 3,280,407:

This rejection is respectfully traversed because the "float" of Aaron is the cup 50. No other element of the Aaron device functions as a float, as is made clear by the description at column 2, line 70 of Aaron: "It can be seen that if the water level rises, due to buoyancy the cup 50 will rise and bear against the cover...." And, as is clearly shown in Aaron's figure, the cup 50 contacts the flexible tubing at only a single attachment point, 72. Thus, Aaron fails to teach a float that attaches to the flexible tubing at two attachments points (a limitation that is positively required by all of the pending claims).

Likewise, the first end of 48 of Aaron's flexible tube is dimensioned and configured to attach to a toilet tank outlet, in the same fashion as required by the present claims. However, the second end of the Aaron's flexible tubing extends above the water line by virtue of its attachment to the outer wall 54 of Aaron's cup 50. In contrast, the present claims positively require that the second end of the flexible tubing is submerged within the liquid in the tank.

A comparison between Applicant's Fig. 6 and Aaron's Fig. 1 illustrates this critical difference. In Applicant's Fig. 6, the second end 35 of the flexible tubing is clearly submerged within the liquid in the tank. There is no additional conduit or

tubing that elevates Applicant's second end 35 of the tubing above the water line. The second end 35 is literally submerged in the water. In contrast, in the Aaron device, the second end of flexible tubing 72 is attached to the outer wall 54 of the cup 50. The result is that the passage formed by Aaron's flexible ends above the water line. In short the element in Aaron that corresponds to the presently recited "flexible tubing" is the entire length of Aaron's tube 30 and the outer wall 54 of the cup 50. The opening of the second end of Aaron's tube is not, therefore, submerged below the water line, as is required by the present claims.

Applicants therefore submit that the rejection of Claims 6-9 under §102(b) in view of Aaron is improper. Withdrawal of the same is respectfully requested.

Rejection of Claims 10-23 Under §103(a) in View of Aaron in Combination with Applicant's Disclosure at Page 5, Second Full Paragraph:

This rejection is respectfully traversed.

As noted in the prior section, the "float" of Aaron is the cup 50. No other element of the Aaron device functions as a float. Again, see Aaron at column 2, line 70: "It can be seen that if the water level rises, due to buoyancy the cup 50 will rise and bear against the cover...." The cup 50 of Aaron contacts the flexible tubing at only a single attachment point, 72. Thus, Aaron fails to teach a float that attaches to the flexible tubing at two attachment points (a limitation that is positively required by all of the pending claims).

Also as noted earlier, the second end of the Aaron's flexible tubing extends above the water line by virtue of its attachment to the outer wall 54 of Aaron's cup 50. In contrast, the present claims positively require that the second end of the flexible tubing is submerged within the liquid in the tank.

A comparison between Applicant's Fig. 6 and Aaron's Fig. 1 illustrates this critical difference. In Applicant's Fig. 6, the second end 35 of the flexible tubing is clearly submerged within the liquid in the tank. There is no additional conduit or tubing that elevates Applicant's second end 35 of the tubing above the water line. The

second end 35 is literally submerged in the water. In contrast, in the Aaron device, the second end of flexible tubing 72 is attached to the outer wall 54 of the cup 50. The result is that the passage formed by Aaron's flexible ends above the water line. In short the element in Aaron that corresponds to the presently recited "flexible tubing" is the entire length of Aaron's tube 30 and the outer wall 54 of the cup 50. The opening of the second end of Aaron's tube is not, therefore, submerged below the water line, as is required by the present claims.

Combining Aaron at all with the Applicant's own words do not cure the shortcomings of the Aaron patent because the Applicant's own specification is not prior art. The Office is not free to use the Applicant's own disclosure to provide the elements that are not shown in the applied prior art. Therefore, the combination of Aaron with the Applicant's own statements at page 5 of the specification as filed neither teach nor fairly suggest the claimed invention.

Applicants further traverse this rejection because the statement cited by the Office is not an admission against interest and is not an admission that the fill tube is in the prior art. The entire passage states "It is also an important note that fill tube 29, used to fill the toilet bowl, is not necessarily need with this type of flush valve." The Applicant is quite clearly referring to his own invention, not to any generic "type" of flush valve. Applicant therefore traverses the reliance upon this statement as being an improper use of Applicant's own disclosure, which is not part of the prior art.

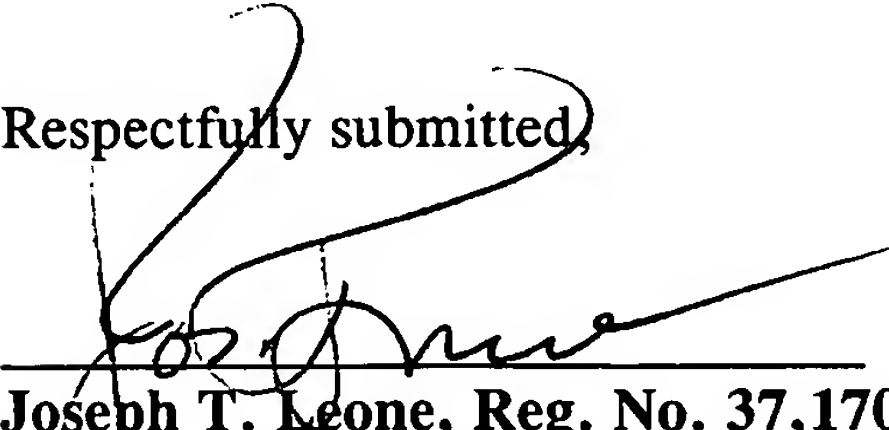
Lastly, Applicant notes that all of Claims 10-23 require a fill valve and fill tube, neither of which are shown or suggested by Aaron at all. Thus, whether or not the invention can be made to function in the absence of this element is irrelevant because the claims at issue positively require a fill valve and fill tube. As noted above Applicant's statement relied upon by the Office is not an admission against interest, nor an admission of what is in the prior art. In short, the claims require a fill tube/fill valve, and the Aaron reference neither teaches nor suggests using a fill tube/fill valve. As a consequence, the combination of Aaron with Applicant's own disclosure (which, as noted above, cannot be used in this fashion) is improper.

Applicant therefore submits that the rejection of Claims 10-23 under §103(a) in view of Aaron in combination with Applicant's disclosure at page 5, second full paragraph is improper. Withdrawal of the same is respectfully requested.

CONCLUSION

Applicants submit that the application is now in condition for allowance. Early notification of such action is earnestly solicited.

Respectfully submitted,



Joseph T. Leone, Reg. No. 37,170
DEWITT ROSS & STEVENS S.C.
8000 Excelsior Drive, Suite 401
Madison, Wisconsin 53717-1914
Telephone: (608) 831-2100
Facsimile: (608) 831-2106